

ESTTA Tracking number: **ESTTA475291**Filing date: **05/30/2012**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	Your Photo On Canvas, LLC		
Entity	LLC	Citizenship	California
Address	8050 East Crystal Drive Anaheim, CA 92807 UNITED STATES		

Correspondence information	Roger N. Behle, Jr. Foley Bezek Behle & Curtis, LLP 575 Anton Blvd., Ste 710 Costa Mesa, CA 92626 UNITED STATES rbehle@foleybezek.com Phone:714-556-1700
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**Registration Subject to Cancellation**

Registration No	4151869	Registration date	05/29/2012
Registrant	Malovani Design Corp. 1908 Farrell Avenue, #B Redondo Beach, CA 90278 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 016. First Use: 2007/10/14 First Use In Commerce: 2007/10/14 All goods and services in the class are cancelled, namely: Art prints; Art prints on canvas; Canvas for printing; Color prints; Giclee prints; Photographic prints; Photographs; Photographs that have been computer manipulated and enhanced to look like paintings; Prints; Prints in the nature of photographs
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**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Registrant is not the owner of the Mark as of the filing date. 15 U.S.C. Â§ 1051(a); 37 C.F.R. Â§ 2.71(d); and Huang v. Tzu Wei Chen Food Co., 849 F. 2d 1458, 7 USPQ 2d 1335 (Fed. Cir. 1988).

Related Proceedings	Notice of Opposition for Trademark Application No. 85252823; Opposition No. 91205200
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Attachments	YPOC Petition to Cancel 5 29 12.pdf ( 8 pages )(988844 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/roger n. behle, jr./
Name	Roger N. Behle, Jr.
Date	05/30/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the matter of:** Trademark Registration No. 4151869, on the Supplemental Register  
**Mark:** Your Photo On Canvas  
**Date Filed:** February 23, 2011

<p>YOUR PHOTO ON CANVAS, LLC,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">vs.</p> <p>MALOVANI DESIGN CORP.,</p> <p style="text-align: center;">Registrant.</p>	<p>Cancellation No. _____</p>
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**PETITION TO CANCEL**

Petitioner, Your Photo On Canvas, LLC, is a California limited liability company located and doing business at 8050 East Crystal Drive, Anaheim, California 92807.

To the best of Petitioner's knowledge, the name of the registrant is Malovani Design Corp., a California corporation located and doing business at 1908 Farrell Avenue, #B, Redondo Beach, California 90278.

The above-identified petitioner believes that it has been and/or will be damaged by the continuing registration of the mark YOUR PHOTO ON CANVAS ("Mark") on the Supplemental Register, and hereby petitions to cancel the same.

**BASIS FOR CANCELLATION**

**STATEMENT OF FACTS**

1. Malovani Design Corp. ("Registrant") was not the owner of the Mark as of the application filing date, February 23, 2011. 15 U.S.C. § 1051(a). Since Registrant did not own the

Mark on the application filing date, the application is void. 37 C.F.R. § 2.71(d); *Huang v. Tzu Wei Chen Food Co.*, 849 F. 2d 1458, 7 USPQ 2d 1335 (Fed. Cir. 1988). Trademark Manual of Examining Procedure (“TMEP”) §1201.

2. Registrant filed the above-identified trademark application in the United States Patent and Trademark Office (“USPTO”) on February 23, 2011 (“Application”) to register the Mark for use in connection with “Art prints; Art prints on canvas; Canvas for printing; Color prints; Giclee prints; Photographic prints; Photographs; Photographs that have been computer manipulated and enhanced to look like paintings; Prints; Prints in the nature of photographs,” all in International Class 016. The application lists Registrant (“Malovani Design Corp.”) as the owner of the Mark. Under the heading “Legal Entity Type,” the application identifies Registrant as a California Corporation. Registrant claims first use in commerce as October 14, 2007.

3. On May 25, 2011, the examining attorney at the USPTO issued an Office Action refusing registration of the Mark on the Principal Register on the grounds that the Mark was merely descriptive. Registrant failed to respond to the Office action and the Application was abandoned on January 3, 2012. Registrant revived the Application, and the examining attorney issued another Office Action on February 7, 2012, again refusing registration on the grounds that the Mark was merely descriptive. Registrant never submitted any evidence or arguments to overcome the descriptiveness refusal. Pursuant to an examiner’s amendment, however, the Application was amended to the Supplemental Register on March 28, 2012. The Mark was registered on the Supplemental Register on May 29, 2012.

4. As of February 23, 2011, the date the Application was filed, Registrant was not the owner of the Mark. Registrant purports to have assigned the Mark to an individual, Adam Malovani, effective as of October 1, 2007, a full three and one-half years before Registrant filed the present Application to register the Mark. A true and correct copy of the assignment agreement (“Assignment”) between Applicant and Adam Malovani is attached hereto as Exhibit A, a made a part hereof by this reference.

5. In the Assignment, Registrant purports to have assigned, transferred and set over unto Adam Malovani, an individual, all of Registrant’s “right, title and interest” in and to the Mark. The Assignment shows that the Mark was assigned to Adam Malovani by Registrant (on October 1, 2007) prior to the claimed first use of the Mark (October 19, 2007).

6. Adam Malovani was formerly employed by Petitioner. At no time during the course of his employment with Petitioner did Adam Malovani ever disclose the existence of the Assignment to Petitioner, nor did he provide Petitioner with a copy of the Assignment. Based on Adam Malovani's statements and representations, Petitioner was led to believe that it could use the descriptive words "Your Photo on Canvas" in connection with its business.

#### **PETITIONERS STANDING TO FILE**

7. Petitioner operates a business under the name "Your Photo On Canvas" and has expended time and resources in developing its business. Petitioner would be harmed if Registrant is permitted to maintain registration of the Mark on the Supplemental Register, particularly in light of the alleged Assignment.

#### **GROUND ALLEGED FOR CANCELLATION**

##### Registrant is Not the Owner of the Mark

8. On information and belief, and according to Adam Malovani, Registrant is not the rightful owner of the Mark. By assigning the Mark to Adam Malovani, as evidenced by the Assignment, Registrant did not own the Mark at the time the Application was filed (February 23, 2011) and, pursuant to 15 U.S.C. § 1051, the Application is void as filed. Only the owner of a mark may apply to register the mark. TMEP §§ 803.01, 803.06, and 1201.02(b).

9. An application for a federal trademark registration must be made by the "owner" of trademark; principal officers and/or shareholders of a corporation are not "owners" of a mark when the corporation uses the mark in commerce.

10. For the foregoing reasons, the registration issued to Registrant should be cancelled as Adam Malovani claims that Registrant is not the rightful owner of the Mark. Petitioner would be damaged by the registration, particularly in light of the alleged Assignment.

##### Fraud

11. Registrant knowingly made false, material representations of facts in connection with its Application by representing to the USPTO that it was the owner of the Mark, when in fact it purported to assign all of its rights in the Mark to Adam Malovani.

12. Registrant made the representation with the intention that the USPTO would rely on this representation in registering the Mark on the Supplemental Register.

WHEREFORE, Petitioner believes that it will be damaged if the Mark is allowed to remain registered on the Supplemental Register and Petitioner prays that Trademark Registration

No. 4151869 be canceled immediately, and that this Petition to Cancel be sustained in favor of Petitioners, with costs and legal fees awarded, if appropriate, pursuant to Federal Rules of Civil Procedure and the Rules of the USPTO and the TTAB.

Dated: May 30, 2012

FOLEY BEZEK BEHLE & CURTIS, LLP

/Roger N. Behle, Jr./

Roger N. Behle, Jr.

Attorney for Petitioner Your Photo On Canvas,  
LLC.

# EXHIBIT A

# EXHIBIT A

## **Assignment Agreement**

This assignment agreement memorializes an assignment of rights effective as of October 1, 2007 (the "Assignment"). The Assignment is by and between Malovani Design Corporation ("Design Company" or "Assignor") and Adam Malovani ("Malovani" or "Assignee"). Design Company and Malovani are collectively referred to herein as the "Parties".

### **RECITALS**

WHEREAS, Design Company is the owner and holder of the trademark and trade name "Your Photo On Canvas" (the "YPOC Brand"). Malovani is the owner of Design Company.

WHEREAS, Design Company wishes to memorialize the assignment between it and Malovani for Malovani, among other things: (a) to take steps necessary to register and maintain the YPOC Brand with the United States Patents and Trademark Office; (b) to license the YPOC Brand to third parties; and (c) to enforce common law, statutory and contractual rights arising from the YPOC Brand and the licensing of same.

NOW THEREFORE, for good and valuable consideration, the mutual receipt and legal sufficiency of which are hereby acknowledged, the Assignor hereby assigns, transfers and sets over unto Assignee, all of Assignor's right, title and interest in and to the YPOC Brand, including but not limited to claims, causes of action, damages, penalties, costs and expenses (including attorney fees) relating to, arising out of, or in connection with the YPOC Brand.

The parties shall, upon request of the other, execute and deliver such further documents (in form and substance reasonably acceptable to the party to be charged) and do such other acts and things as are reasonably necessary and appropriate to effectuate the terms and conditions of this Assignment.

[Signatures on Next Page]



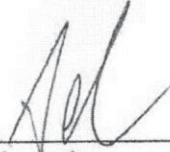
IN WITNESS WHEREOF, this Assignment has been executed as of the date first above written.

**ASSIGNOR**



Adam Malovani, President  
For Malovani Design Corporation

**ASSIGNEE**



Adam Malovani

CERTIFICATE OF SERVICE

It is hereby certified that on the 30th day of May, 2012, the foregoing PETITION TO  
CANCEL was served on Registrant by sending a copy thereof to:

Adam Malovani  
Malovani Design Corp.  
1908 Farrell Ave., #B  
Redondo Beach, California 90278  
UNITED STATES

Registrant, by first-class, postage-prepaid mail.

Dated: May 30, 2012

FOLEY BEZEK BEHLE & CURTIS, LLP

/Roger N. Behle, Jr./

Roger N. Behle, Jr.  
Attorney for Petitioner